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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,911	11/11/2003	Chang Han Shen	105199-638-RI	2377

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EXAMINER


JOHNSON, BLAIR M

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/712,911	Applicant(s) - SHEN, CHANG HAN	
	Examiner Blair M. Johnson	Art Unit 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Reissue Applications

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

Claims 3-14 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Claims 3,5,7,8,10 and 13 do not include the annular body of the patented claims. In arguing for the patentability of the claims over the prior art during the prosecution of

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US patent No. 6,431,245, Applicant argued that the prior art "does not show the use of the 'annular member' located on the bottom tube", page 6 of the only amendment in the prosecution of '245.

Also omitted from claims 3 and 7, et al, are the "locating means" and the "active pull cord", both of which were argued as injecting patentable subject matter into the eventual patent claims of '245. The relationship of the side pull cords and the middle pull cord, still recited, with the active pull cord and the locating member is extensively discussed on page 5 of the arguments of the '245 amendment. At the bottom of page 5 is the statement: "This structure allows the present invention to achieve advantages neither shown or suggested by the prior art Rupel and Schon patents". Additionally, on page 6 of these same arguments, Applicant stated the prior art "still lack[s] the arrangement of pull cords connected to the locating member, and would still lack the ability to easily manipulate the window shade into the unique form shown in the drawings of the present invention". Also, claim 7 fails to include the tubes as originally recited. Applicant, on page 7 of the aforementioned amendment, argues: "that without the middle tube, it is not possible to achieve a clear and uncrumpled presentation of the curved portion of the window shade. On this basis, Applicant respectfully contends that the present invention is patentably distinguishable from the prior art references". Also stated in regards to the tubes, on page 6: "Importantly, the Rupel patent does not use the middle tube. As a result, it is not possible to achieve the advantage of the present invention by lifting the bottom tube upwardly toward the middle tube with out lifting the

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entire shade so as to achieve the configuration shown in FIGURE 3 of the Rupel patent." Currently, claim 7 omits this highly praised feature.

Office policy is directed by the following decisions: Pannu V. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 ; Ex parte Yamaguchi, 61 USPQ2d 1043.

Among the criteria for evaluating recapture, it must be determined whether the reissue claim entirely omits any limitation that was argued during the original prosecution to overcome an art rejection (Pannu). The "annular body", "locating member", "active pull cord" and tube features, now omitted in the independent claims 3 and 7, as well as certain dependent claims, were argued as being patentable over the prior art applied, as carefully detailed above. It is to be emphasized that these features have not been broadened, they have been omitted altogether.

MPEP 1412.02 is very clear that arguments alone can establish surrendered subject matter. Again, this applies to the present facts.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rupel '257.

See top rail 15, pull cord 18, first side cord 19 and second side cord 20. The "sections" are comprised of bottom section 17a-c, top section where the shade is attached to the headrail 15, and "therebetween section" between the top and bottom sections. Pull cord 18 is attached to the bottom section and the side cords are attached to the "therebetween section" by virtue of the going through the holes in the pleated shade. What is not shown is cord 18 going through the same "arresting member" as cords 19 and 20. However, merely rerouting cord 18 through the right end of the headrail, i.e. locating lock 25 adjacent lock 27, would have been obvious so as to provide complete activation of the shade from one side of the blind. See the annular body in the form of circular hole C'. The actuating members are the holes in the headrail through which cords 18 and 19 extend and are redirected by.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blair M. Johnson whose telephone number is (703) 308-0526. The examiner can normally be reached on Mon.-Fri., 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Blair M. Johnson
Primary Examiner
Art Unit 3634

BMJ
11/16/04